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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,646	10/25/2000	Jouko Tenhunen	442-009870-US(PAR)	3188

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PERMAN & GREEN
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EXAMINER	
YUN, EUGENE	

ART UNIT	PAPER NUMBER
2682	

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/696,646	TENHUNEN, JOUKO	
	Examiner	Art Unit	
	Eugene Yun	2682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-35 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-35 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 25 October 2000 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-8, 13-23, 27-32, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amin (US 6,014,559) in view of Quinn (US 5,944,786).

Referring to Claim 1, Amin teaches a method for erasing a notification message in a terminal, which terminal communicates with a network over a radio interface, which method comprises:

storing a specific first information in a specific system outside the terminal 102 and 106 (fig. 1);

transmitting to the terminal over said radio interface a notification message as a sign of said storing (see col. 6, lines 10-13);

Amin does not teach storing said notification message in a memory of the terminal, wherein the method comprises:

contacting from the terminal a specific address for gaining access to said first information based on said notification message; and

erasing from the memory of the terminal said notification message in response to a specific procedure relating to said contacting.

Quinn teaches storing said notification message in a memory of the terminal (see col. 9, lines 18-21), wherein the method comprises:

contacting from the terminal a specific address for gaining access to said first information based on said notification message (see col. 9, lines 22-26); and

erasing from the memory of the terminal said notification message in response to a specific procedure relating to said contacting (see col. 9, lines 32-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Quinn to said method of Amin in order to better assure that a subscriber of a cellular network receives all waiting messages.

Claims 16 and 30 have similar limitations to Claim 1.

Referring to Claim 2, Amin also teaches the first information to which information said terminal gains access is stored in the specific system outside the terminal, for said terminal (see 102 and 106 in fig. 1).

Referring to Claims 3 and 18, Amin also teaches the first information as a message intended for the terminal, which is stored for the terminal in an electric format in the specific system outside the terminal (see col. 1, lines 59-67).

Referring to Claims 4 and 19, Amin also teaches the message intended for the terminal as one of the following: voice message; video recording message; multimedia message; fax; and electronic mail message (see ABSTRACT).

Referring to Claim 5 and 20, Quinn also teaches said specific procedure in response to which said notification message is erased, is one of the following: initiation

of contacting said specific address, establishment of contact; and disconnecting (see col. 9, lines 32-40).

Referring to Claims 6, 8, and 23, Quinn also teaches storing in the memory of the terminal said specific number by calling of which the call will connect to said system outside the terminal (see col. 9, lines 22-30);

checking when making a call from the terminal, whether the number which is called is said specific number by comparing the number which is called to said specific number stored in the terminal (see col. 9, lines 32-40); and

if the number which is called is said specific number, identifying from among the messages that originate from said system outside the terminal, and erasing the identified notification messages (see col. 9, lines 32-40).

Referring to Claims 7, 22 and 32, Quinn also teaches wherein contacting from the terminal said specific address for gaining access to said first information is effected by making a call from the terminal to a specific number (see col. 9, lines 22-26); and

erasing the notification message is effected in response to one of the following procedures: making a call to said specific number; said specific system outside the terminal answering the call; and terminating off said call (see col. 9, lines 32-40).

Referring to Claims 13, 27, and 34, Amin also teaches the system outside the terminal is one of the following: voice mail system; video recording message system; multimedia messaging system; fax mailbox service; remote mail service (see 102 in fig. 1).

Referring to Claims 14 and 28, Amin also teaches the notification message as one of the following: SMS message; WAP message; and message according a packet switched protocol (see col. 5, lines 13-16).

Referring to Claims 15 and 29, Amin also teaches the terminal as one of the following: telephone of a cellular network; and computer terminal (see fig. 1).

Referring to Claims 17 and 35, Quinn also teaches the memory located in one of the following: the terminal itself and a separate memory (see col. 9, lines 18-21).

Referring to Claims 21 and 31, Quinn also teaches the memory further configured to store concurrently a plurality of notification messages and respective specific addresses (see col. 8, lines 55-62); and the terminal further comprises:

means for determining when contact to any of said specific addresses is made or is being made (see col. 9, lines 22-26);

means for identifying from among the plurality of notification messages stored in the memory any notification messages corresponding to such a specific address for which the contacting is determined (see col. 9, lines 22-26); and

the memory is configured to erase any identified notification messages (see col. 9, lines 32-40).

3. Claims 9-12, 24-26, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amin and Quinn in view of Kaisto (WO 96/25817 "IDS").

Referring to Claims 9 and 24, the combination of Amin and Quinn does not teach at least two specific numbers by calling of which the call will connect to said system

outside the terminal. Kaisto also teaches at least two specific numbers by calling of which the call will connect to said system outside the terminal (see pg. 11, lines 1-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Kaisto to said method of Amin in order to ensure a better connection to the outside system from the terminal.

Referring to Claim 10, Kaisto also teaches the identification of notification messages carried out by comparing the CLI data (Calling Line Identity) of the messages stored in the memory of the terminal to said specific number stored in the terminal (see pg. 12, lines 5-8).

Referring to Claim 11, 25, and 33, Kaisto also teaches storing in advance in the memory of the terminal a reference file, which is for its essential parts identical to said notification message stored in the memory of the terminal (see pg. 14, lines 24-35 and pg. 15, lines 1-3); and

said identification of notification messages is carried out by comparing the content of the messages stored in the memory of the terminal to the content of said reference message (see pg. 12, lines 25-35 and pg. 13, line 1).

Referring to Claims 12 and 26, Kaisto also teaches said notification message transmitted to and stored in the terminal comprising a message structure and in its message structure, a control bit pattern, which control bit pattern is used for identifying notification messages originating from the system outside the terminal (see pg. 15, lines 4-17).

Response to Arguments

4. Applicant's arguments filed 5/2/2005 have been fully considered but they are not persuasive.

Firstly, it is inherent to one skilled in the art that even if the notification message itself is stored in an outside server, it is obvious that the notification message, whether it is LED, tone, or display based, is stored in a temporary buffer in a user terminal in order for a user of the user terminal to be informed of an incoming stored message.

Referring now to the Quinn reference, the user terminals 24 or 32 or both as shown in col. 7, lines 42-46 as well as user terminals 14 all contain the temporary buffers described above. First of all, the notification device 24 needs some sort of temporary RAM or memory buffer device in order to be able to perform the multiple flashing of lights according to the number of unread emails as shown in col. 8, lines 55-62. Second of all, it is inherent that the terminal 14 contains a display buffer in order for the text display means to display the notification message. The argument by the applicant that states that the device in fig. 4 "corresponds to transmitting e-mail without any prior notification at all" is incorrect. Referring to col. 10, lines 22-38, it clearly states that there is indeed a notification message that is included with the incoming email and that the notification message is displayed in the LCD screen. Therefore, that means that the terminal 14 does indeed include a display buffer that stores a notification message until a user retrieves the stored email message in which the notification message is erased.

Because of the above reasons, the examiner still believes that the Quinn reference teaches the limitations of storing said notification message in a memory of the terminal, wherein the method comprises contacting from the terminal a specific address for gaining access to said first information based on said notification message, and erasing from the memory of the terminal said notification message in response to a specific procedure relating to said contacting.

5. Applicant's arguments with respect to claims 17-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (571) 272-7860. The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eugene Yun
Examiner
Art Unit 2682

EY

NICK CORSARO
PRIMARY EXAMINER